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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/526,406

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EXAMINER

BRUSCA, JOHN S

ART UNIT

PAPER NUMBER

1631

MAIL DATE

DELIVERY MODE

12/12/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/526,406	Applicant(s) TANUMA ET AL.	
	Examiner John S. Brusca	Art Unit 1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-30,32 and 34-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 32 and 46 is/are allowed.
- 6) ☒ Claim(s) 28-30,32 and 34-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/26/2006, 10/9/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group 3, claims 28-30, 32, and new claims 34-46 in the reply filed on 25 September 2008 is acknowledged.
2. The applicants have cancelled claims 1-27, 31, and 33 drawn to nonelected Groups 1 and 2 in the amendment filed 25 September 2008.

Status of the Claims

3. Claims 28-30, 32, and 34-46 are pending.
Claims 28-30, 32, and 34-46 are rejected.
Claims 32 and 46 are allowable.

Specification

4. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR §§ 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR §§ 1.821-1.825 for the following reasons:

Several nucleotide sequences appear in the specification in figure 20 that are not properly identified. Nucleotide sequences must be identified by sequence identification number. Furthermore, if said sequences do not appear in the sequence listing, a new listing including said sequences must be supplied. It is often convenient to identify sequences in figures by amending the Brief Description of the Drawings section (see MPEP 2422.02). If said sequences consist of a portion of sequences already of record in the sequence listing, they may be identified in the specification using the existing SEQ ID No. accompanied by the position of the sequence on the already listed sequence.

Art Unit: 1631

Applicants are required to comply with all the requirements of 37 CFR §§ 1.821-1.825. Any response to this Office Action which fails to meet all of these requirements will be considered non-responsive. The nature of the sequences disclosed in the instant application has allowed an examination on the merits, the results of which are communicated below.

Information Disclosure Statement

5. The information disclosure statements (IDS) submitted on 26 June 2006 and 09 October 2008 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements are being considered by the examiner.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 28-30 and 41-44 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 28-30 and 41-44 are drawn to a program per se and do not have a limitation that they are on a computer readable medium. Therefore the subject matter reads on printed matter and is not statutory subject matter.

8. Claim 28, 34-38, and 41-45 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

For a process that comprises an abstract idea to be statutory, it must comprise a practical application of the abstract idea. Claimed subject matter may require a practical application by claiming, or requiring use of, a machine, or by requiring a physical transformation of an article to a different state or thing (In Re Bilski (88 USPQ2d 1385 Fed. Cir. 2008). Even if claimed subject

Art Unit: 1631

matter claims, or requires use of, a machine, the claimed subject matter may not require a practical application. One indication that claimed subject matter requires a practical application is an explicit requirement of a useful concrete, and tangible result as discussed in *In re Alappat* (31 USPQ2d 1545 Fed. Cir. 1994)

Although many, or arguably even all, ²² of the means elements recited in claim 15 represent circuitry elements that perform mathematical calculations, which is essentially true of all digital electrical circuits, the claimed invention as a whole is directed to a combination of interrelated elements which combine to form a machine for converting discrete waveform data samples into anti-aliased pixel illumination intensity data to be displayed on a display means. ²³ This is not a disembodied mathematical concept which may be characterized as an “abstract idea,” but rather a specific machine to produce a useful, concrete, and tangible result.

In determining if the claimed subject matter produces a useful, concrete, and tangible result, the Examiner must determine each standard individually. For a claim to be “useful” the claim must produce a result that is specific and substantial. For a claim to be “concrete” the process must have a result that is reproducible. For a claim to be “tangible” the process must produce a real world result . Furthermore, the claim must be limited only to statutory embodiments.

Claims 28, 34-38, and 41-45 do not require production of a tangible result in a form that is understandable to the user of the process or apparatus. The claims do not require that the sequence of the selected peptide produced by the method or program of the claims is presented to the user in a form that is understandable. A tangible result requires that the claim must set forth a practical application to produce a real-world result. This rejection could be overcome by amendment of the claims to recite that a result of the process is outputted to a display, or to a user, or in a graphical format, or in a user readable format, or on a tangible medium, or by

Art Unit: 1631

including a result that is a physical transformation. The applicants are cautioned against introduction of new matter in an amendment.

9. Claim 45 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

10. Claims 45 is drawn to a computer program on computer readable media. A review of the specification does not show a definition of computer readable media such that excludes an embodiment that is information in a signal. On page 70 of the specification the computer readable recording medium of claim 45 is described as follows:

Here, a “computer-readable recording medium” refers to an optionally chosen recording medium capable of recording electronic data, and readable by a computer as necessary, and is exemplified by portable information recording media such as magnetic tapes, magnetic discs, magnetic drums, IC cards, and 30 optical discs (e.g., CD, DVD).

The description of computer readable recording medium does not exclude a medium that is a signal because data can be stored temporarily in a signal for subsequent input to a computer receiving the signal. As such an embodiment of the claims read on non-statutory subject matter (In re Nuijten 84 USPQ2d 1495 (2007)). The applicants may overcome the rejection by amendment of the claims to be limited to physical forms of computer readable media described in the specification, or if no description exists for physical computer readable media, by presenting a statement that the claims do not read on embodiments that are not physical computer readable media that are conventional in the art.

11. Claims 34-40 are rejected under 35 U.S.C. 101 because these claims are drawn to non-statutory subject matter.

Art Unit: 1631

Claims 34-40 are drawn to a process. A process is statutory subject matter under 35 U.S.C. 101 if: (1) it is tied to a particular machine or apparatus or (2) it transforms an article to a different state or thing (In re Bilski, 88 USPQ2d 1385 Fed. Cir. 2008).

The claimed subject matter is not limited to a particular apparatus or machine. To qualify as a statutory process, the claims should require use of a machine within the steps of the claimed subject matter or require transformation of an article to a different state or thing. Insignificant extra-solution activity in the claimed subject matter will not be considered sufficient to convert a process that otherwise recites only mental steps into statutory subject matter. Preamble limitations that require the claimed process to comprise machine implemented steps will not be considered sufficient to convert a process that otherwise recites only mental steps into statutory subject matter. The applicants are cautioned against introduction of new matter in an amendment.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John S. Brusca whose telephone number is 571 272-0714. The examiner can normally be reached on M-F 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marjorie A. Moran can be reached on 571-272-0720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1631

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John S. Brusca/
Primary Examiner
Art Unit 1631

jsb